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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/642,365

08/14/2003

Michael S. H. Chu

MIY-GIP-001

1647

23517 7590 08/03/2009  
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EXAMINER

RYCKMAN, MELISSA K

ART UNIT

PAPER NUMBER

3773

MAIL DATE

DELIVERY MODE

08/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/642,365	<b>Applicant(s)</b> CHU ET AL.	
	<b>Examiner</b> MELISSA RYCKMAN	<b>Art Unit</b> 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/26/09.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-52 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 12 and 14-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 13 and 44-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/5/08, 3/2/09</u>   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/26/09 has been entered.

The newly amended claims are given priority to 8/14/02, as the earlier dates of the CIP applications do not include the first and second legs as stated in the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 11-13, 44-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giesy et al. (U.S. Patent No. 5,152,749) and further in view of Skiba et al. (U.S. Patent No. 6,723,107)

Giesy teaches an implant placement device comprising the following:

- a connector pair (44, 46) for attaching a medical implant (40) to a delivery device (10)

Art Unit: 3773

- the connector pair comprising, a closed loop connector (44) located at an end of a medical implant (40)
- a slotted connector (46) formed in a distal end (20b) of a shaft (20) of a delivery device (10)
  - for interfitting with the closed loop connector of the medical implant (fig. 3)
  - the distal end of the shaft includes a tapered section (Fig. 4) that is substantially straight and conical
  - the tapered section of the shaft is substantially straight (Fig. 3, shows straight distal end)
  - the distal tip is blunt (Fig. 3)

Geisy fails to disclose wherein the slotted connector includes first and second legs the first leg extending radially into the shaft and the second leg extending axially in a distal direction from the first leg along the shaft and being longer than the first leg and includes a narrowing for locking the looped connector into the second leg. Skiba teaches a device for holding a suture material comprising a slotted connector, wherein the slotted connector includes first and second legs, the first leg extending radially into the shaft and the second leg extending axially in a distal direction from the first leg along the shaft and being longer than the first leg and includes a narrowing in order to permit easy insertion of the suture into the opening and to wedge the suture into tight frictional engagement with the device (Fig. 20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Giesy with a slotted connector as taught by

Art Unit: 3773

Skiba in order to permit easy insertion of the suture into the opening and to wedge the suture into tight frictional engagement with the device.

The combination of Giesy and Skiba further teaches the following limitations

- wherein the second leg is longer than the first leg (Skiba, Fig. 20)
- the second leg extends distally at a 90 degree angle to the first leg (Skiba, Fig. 20)
- the narrowing is formed where the second leg initially extends from the first leg (Skiba, Fig. 20)
- the width of the narrowing is less than that of the loop material (Geisy)
- The second leg of the slotted connector extends axially into the tapered section of the shaft (Skiba, Fig. 20)
- The first leg of the slotted connector is proximal of the tapered section of the shaft (Skiba, Fig. 20)
- The distal tip is solid (Skiba, Fig. 20)
- the first and second legs join at an inside corner and an outside corner (Skiba, Fig. 20), the outside corner being located proximal to the inside corner along the shaft

The embodiment of Skiba as shown in Fig. 20 shows the first and second legs formed at a 90 degree angle, but does not show the outside corner is curved and the inside corner is not curved, however the embodiment of Skiba as shown in Fig. 17 shows curved corners. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the embodiments of Skiba to have

Art Unit: 3773

one corner curved and the other not curved as this aids in placement of the loop and in using the device.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA RYCKMAN whose telephone number is (571)272-9969. The examiner can normally be reached on Monday thru Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571)-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Application/Control Number: 10/642,365

Page 6

Art Unit: 3773

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MKR

/Melissa Ryckman/  
Examiner, Art Unit 3773

/Julian W. Woo/  
Primary Examiner, Art Unit 3773